

Atty. Docket No. YO-999-567  
(590.003)

**REMARKS**

The fact that January 1, 2006, fell on a Sunday and Monday, January 2, 2006, was a Federal Holiday ensures that this paper is filed within two months of the mailing date of the outstanding Office Action as it is being filed on January 3, 2006, the next business day.

In the outstanding Office Action dated November 1, 2005, Claims 1, 3-5, 8-31, and 33-35 were rejected and the rejection made final. Specifically, Claims 1, 20, 31, and 33-35 stand rejected under 35 U.S.C. 112, first paragraph. Claims 1, 3-5, 8-22, and 25-31 stand rejected under 35 U.S.C. 103 as unpatentable over Pleso (US Patent No. 6,009,480) in view of Chiles et al. (US Patent No. 6,167,567), in further view of Himmel et al. (US Patent No. 6,041,360). Claims 33-35 stand rejected under 35 U.S.C. 103 as unpatentable over Pleso in view of Chiles and Himmel in further view of Anderson et al. (US Patent No. 6,578,142). Of the rejected claims, Claims 1, 20, and 31 are independent claims; the remaining claims being dependent.

The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

**35 USC 112, First Paragraph, Written Description Rejections**

Independent Claims 1, 20, and 31 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirements, because, as indicated by the Examiner, subject matter is claimed which was not described in the

Atty. Docket No. YO-999-567  
(590.003)

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the invention at the time the application was filed. (Office Action P. 2) The Examiner states, "There is no description in the specification about updating a network location contained within a device upon determination by interface logic that a more recent version of the network location reference is available." (Id.) Applicants respectfully disagree.

In the present application, with regard to at least one preferred embodiment, it is disclosed, "The commands understood by the interface logic 202 preferably support the following functions: ...IV. *Get Link to Device Driver Data*: This function provides a reference to a network location, e.g. URL, where the most recent version of the device driver can be found... . VI. *Update Link*: This function allows to update the location of where to find the latest version of a given device driver." (Pages 6-7). Thus, Applicants have "reasonably convey[ed] to the artisan that the inventor had possession at the time of the later claimed subject matter," *Ralston Purina Co. v. FarMar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985), so as to satisfy the statutory requirements for a written description.

Claims 33-35 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirements, because, as indicated by the Examiner, subject matter is claimed which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the invention at the time the application was filed. (Office Action P. 2) The Examiner states, "There is no description in the specification about interface logic that is adapted to

Atty. Docket No. YO-999-567  
(590.003)

query a computer user whether to initiate a low-bandwidth transfer of the device driver upon recognition of a low-bandwidth connection.” (Office Action Pgs. 2-3) Applicants again respectfully disagree for the following reasons.

The present application discloses, *inter alia*, “A further variation on the basic algorithm described above and shown in Figure 3 resides in querying the user as to whether to download a new driver in cases of a low-bandwidth connection (e.g. phone line). The user may then decide to defer the download to a time when a better connection becomes available.” (Page 10) Clearly, the specification has provided explicit support for the subject matter presently claimed such that “[p]ersons of ordinary skill in the art [would] recognize that [Applicants] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989).

For the aforementioned reasons, Applicants respectfully request the Examiner’s reconsideration and withdrawal of the outstanding 35 U.S.C. 112, first paragraph, written description rejections.

#### 35 U.S.C. 103(a) Rejections

As specifically set forth above, all of the Claims stand rejected under 35 U.S.C. §103(a) as being obvious over Pleso, in view of various combination of Chiles, Himmel, and/or Anderson. Applicants’ remarks set forth in the August 18, 2005, Amendment included reasons why any Section 103 rejections based on Pleso in view of Chiles should be withdrawn and/or their inapplicability to the claims being amended therein. These remarks remain equally applicable to the present rejections, in as much as the present

Atty. Docket No. YO-999-567  
(590.003)

rejections continue to apply Pleso and Chiles; therefore, these remarks are hereby incorporated by reference as if fully set forth herein.

With respect to independent Claims 1, 20, and 31, the Examiner indicates "Pleso and Chiles teach the limitations of the claim[s] but do not teach updating a network location upon determination that a more recent version of the network location reference is available." (Office Action Pgs. 4, 9, 12) The Himmel et al. reference, however, is said to teach the Claims' element "[w]herein said reference to a network location contained within said device is updated upon determination by said interface logic that a more recent version of the network location reference is available." (e.g., Claim 1)

The Applicants submit that the combined references fail to establish a *prima facie* case of obviousness as required to maintain a rejection under 35 U.S.C. 103(a). As the Examiner is assuredly aware, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be: (1) a suggestion or motivation to modify a reference or combine references; (2) a reasonable expectation of success in making the modification or combination; and (3) a teaching or suggestion to one skilled in the art of all the claim limitations of the invention to which the art is applied. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present instance a *prima facie* case of obviousness has not been demonstrated because the aforementioned requirements have not been satisfied as is discussed below. Therefore, Applicants request the rejections be immediately withdrawn.

Atty. Docket No. YO-999-567  
(590.003)

As has been previously expressed, a motivation to combine Pleso and Chiles does not exist. “[P]rior art referenced in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” *In re Imperato*, 179 USPQ 730 (C.C.P.A. 1973).

If a device such as that described in Pleso were to be coupled to a computing system such as that contemplated in Chiles et al., i.e., a client-server network environment, there would be no need to have a device capable of downloading and integrating to itself an updated network location reference. The device in Pleso would simply download its driver (or indicate where to retrieve such a download) directly into the client computer operating system, which in view of Chiles et al. would be kept up-to-date via the server script and client-server network relationship. As [] indicated in Chiles et al. ... a network administrator maintains a network location reference on a server so that such a location can be expressly controlled by the administrator through the script process, which is at the heart of the Chiles invention. It would run counter to the invention to have a device housing an updateable network reference link, as such would not be needed and would interfere with the control of the network administrators.

(Amendment, dated August 18, 2005, Page 15)

Similarly, there is no motivation to combine Pleso and Chiles with Himmel and, as importantly, the combination would not yield the presently claimed invention. The Office indicates, related to the combination with Himmel, “One of ordinary skill in the art would have been motivated to do so that the network location always refers to a current version of the network location.” (Office Action P. 5) However, as indicated above, no such motivation exists in a system already maintained via network administrator’s update scripts. Simply stated, no advantage is gained in a system based on the combination of the cited references, thus, no motivation to make the combination exists thereby precluding rejection under section 103.

Atty. Docket No. YO-999-567  
(590.003)

Furthermore, in this instance the combination fails to teach or suggest all the presently claimed limitations. Himmel et al., as best understood, relates to "Web Browser Support for Dynamic Update of Bookmarks." (Title) The sections of Himmel cited appear to indicate that an Internet browser will update a bookmark "[w]hen a change is detected in the web page data incorporated in the first bookmark...by virtue of its dynamic attribute to reflect the change in web page data." (Col. 3, lines 1-4) Applicants submit that the updating of a web browser's bookmark is not equivalent to the updating of a network location within a device by interface logic as presently claimed. Therefore to meet the elements of the present claims the Himmel teaching itself would first have to be modified and then this modified version of the Himmel invention would have to be combined with the other references. There is no support for finding any such motivation or expectation of success in such actions exists, which is necessary for a 103 rejection. Thus, any 103 rejection based on such assumptions is inappropriate, because the motivation to make the combinations has already been shown to be lacking and because there is, additionally, no motivation to make the necessary modification of Himmel required, at minimum, to maintain the present 103 rejections.

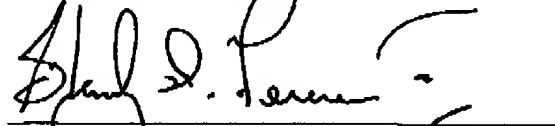
Since, *inter alia*, the cited references fail to teach or suggest all of the limitations as presently claimed and because there is no motivation to make the modifications and combinations necessary to, arguably, present the presently claimed invention, the current rejections should be withdrawn and the independent claims allowed.

In view of the foregoing, it is respectfully submitted that Claims 1, 20, and 31 are fully distinguishable over the applied art and are, thus, presently in condition for

Atty. Docket No. YO-999-567  
(590.003)

allowance. By virtue of their dependence on what is believed to be independent Claims 1, 20, and 31, it is submitted that Claims 3-5, 8-19, 21-22, 25-30, and 33-35 are also presently allowable. Notice to the effect is hereby earnestly solicited. Applicants traverse any remaining rejections and reserve the right to present further argument in support thereof should the need so arise. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted



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